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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,405	03/29/2005	Christian Scheering	2003P00251WOUS	1353
7590 10/05/2007 Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER PARK, JEONG S	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/529,405	SCHEERING, CHRISTIAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeong S. Park	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-22, 24-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22, 24-28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to communications filed July 26, 2007.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17, 19-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer et al. (hereinafter Reichmeyer)(U.S. Patent No. 6,286,038 B1) in view of Choudhry (U.S. Patent No. 6,442,602 B1).

Regarding claims 17, 19, 21, 26 and 33, Reichmeyer teaches as follows:

A method for configuring a device in a data network, comprising the following steps (a method of remotely configuring a network device, see, e.g., abstract);

Storing a domain name in the device that is input by an administrator (DHCP client, 10 in figure 1 or Network device, 61 in figure 8)(Dynamic Host Configuration Protocol (DHCP) assigns dynamic Internet Protocol address to devices on a network, see, e.g., col. 3, lines 62-65);

Transmitting a request message (DHCP request, 18 in figure 1) comprising the stored domain name (server identification or network IP address) to an addressing server (DHCP server, 14 in figure 1) by the device (DHCP client, 10 in figure 1)(DHCP client broadcast DHCP request message to the DHCP server selected, each request message including a server identification, see, e.g., col. 4, lines 14-17);

Receiving a response message (DHCP acknowledge, 20 in figure 8) from the addressing server (DHCP server, 52 in figure 8) by the device (network device, 61 in figure 8), the response message comprising address information of a parameter server (central configuration server, 26 in figure 8, IP address) associated with the device (the network device obtains an IP address for the central configuration server from the DHCP server, see, e.g., col. 7, lines 59-65 and figure 8, steps 18 and 20);

Setting up a connection to the parameter server (central configuration server) by the device, the device using the address information (obtained IP address for the central configuration server) to set up the connection (network device sends a request message, 110 in figure 8, to the central configuration server, see, e.g., col. 7, line 65 to col. 8, line 5); and

Receiving parameters (configuration information) by the device from the parameter server (central configuration server), wherein the parameters are used to configure the device (the central configuration server sends a response message, 116 in figure 8, to the network device including configuration information, see, e.g., col. 8, lines 10-14).

Reichmeyer does not teach that the addressing server is used to convert between domain names and Internet addresses. Because the network device automatically get the network IP address (domain name) associated with the network device so the DHCP server does not need to convert between the domain name and IP addresses.

Choudhry teaches as follows:

Domain name server (DNS) provides the translation between domain names and IP addresses (DNS functions same as the addressing server, see, e.g., col. 2, lines 52-56).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include DNS server to translate between domain names and IP addresses as taught by Choudhry in order to provide names and addresses to network devices automatically without human intervention.

Regarding claims 20, 27 and 32, Reichmeyer teaches as follows:

The Internet protocol addresses of the associated parameter servers (IP address for the central configuration server) and the respective names of domains (IP address for the network device) are stored in the addressing server (DHCP server)(see, e.g., col. 7, lines 59-65);

The address information of the parameter server (IP address for the central configuration server) associated with the device is stored in a text field of a data record belonging to the domain name associated with this device (any protocols used in the network communication have certain form of data unit including text fields to store information); and

The text field is sent to the device as the response (DHCP sever responds with a DHCP offer message, 16 in figure 1 and 8, see, e.g., col. 4, lines 4-10).

Regarding claims 22 and 28, Reichmeyer teaches all the limitations of claims 17 and 26 except for the manual input of the domain name, because the network device automatically learns the domain name by the DHCP mechanism.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include manual input of the domain name in the network device in order not to take advantage of using DHCP automatic discovery of the domain name.

Regarding claims 24, 25 and 36, Reichmeyer teaches all the limitations of claims 17 and 30 except for using a fictitious domain name and a real domain is stored in the device as the domain name.

Choudhry teaches as follows:

Fictitious domain (virtual subdomain name, 53 in figure 5) name does not belong to a real domain (URL is not recognized by the standard DNS is called as the virtual subdomain name, 51 in figure 5, see, e.g., col. 6, lines 36-40 and fig 4);

Both the fictitious domain name (virtual subdomain name, 53 in figure 5) and a real domain name (known domain name, 50 in figure 5) are used (see, e.g., col. 6, lines 53-62 and figure 5);

A first attempt is used to transmit the request message (41 in figure 4) with the real domain name (known domain name, 50 in figure 5) to the addressing server (DNS), if no address information can be ascertained in the addressing server using the domain name transmitted in the first attempt then the addressing server sends a negative acknowledgement message (error 404, 42 in figure 4) to the device as address information (web browser requests URL. If the URL is not recognized by the DNS, the server will return a "error 404:file not found" page to the web browser, see, e.g., col. 6, lines 36-40 and fig 4); and

A terminal using a second attempt send a further request message with the fictitious domain name (virtual subdomain name, 53 in figure 5) to the addressing server (see, e.g., col. 6, lines 58-62 and 53 in figure 5).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include using a fictitious domain name and a real domain as domain name in the process of getting IP addresses from domain names by DNS as taught by Choudhry in order to provide more reliable domain naming service for directing multiple possible domain names to the correct IP address.

Regarding claim 30, Reichmeyer teaches as follows:

An arrangement for configuring a device in a data network (a method of remotely configuring a network device, see, e.g., abstract), the device having a memory for storing a domain name, the arrangement comprising;

A parameter server (central configuration server, 26 in figure 3 and 8) for storing parameters (configuration information), which can be used to configure the device for operation in the data network (the central configuration server sends a response message, 116 in figure 8, to the network device including configuration information, see, e.g., col. 8, lines 10-14);

The device (workstation or network device or DHCP client connected to SDR, 64 in figure 3), the addressing server (DHCP server, 52 in figure 3), and the parameter server (central configuration server, 26 in figure 3) are connected via the data network (see, e.g., col. 5, lines 60-64 and figure 3);

The device is designed to transmit a request message (DHCP request, 18 in

figure 1) to the addressing server (DHCP server, 14 in figure 1)(DHCP client broadcast DHCP request message to the DHCP server selected, see, e.g., col. 4, lines 14-17);

Request message comprising the domain name stored in the device (network device obtained own IP address from the step 12 in fig 8 and use the IP address to communicate with the DHCP server, see, e.g., col. 7, lines 59-65);

The addressing server (DHCP server) is designed to use the domain name transmitted by the device to form a response message comprising an address information of the parameter server (central configuration server IP address) assigned to the device by using the domain name transmitted by the device, in response message transmitted to the device in response to the request message (the network device obtains an IP address for the central configuration server from the DHCP server, see, e.g., col. 7, lines 59-65 and figure 8, steps 18 and 20); and

The parameter server is adapted to send parameters to the device (the central configuration server sends a response message, 116 in figure 8, to the network device including configuration information, see, e.g., col. 8, lines 10-14).

Reichmeyer does not teach that the addressing server is used to allocate domain names to Internet protocol addresses. Because the network device automatically get the network IP address (domain name) associated with the network device so the DHCP server does not need to allocate domain names to IP addresses.

Choudhry teaches as follows:

Domain name server (DNS) provides the translation between domain names and IP addresses (DNS functions same as the addressing server, see, e.g., col. 2, lines 52-



56).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include DNS server to translate between domain names and IP addresses as taught by Choudhry in order to provide names and addresses to network devices automatically without human intervention.

Regarding claim 34, Reichmeyer teaches as follows:

After the device (DHCP device) has been started up, the DHCP method is used to send the domain name for storing to the device and/or the DHCP method is used to assign a valid Internet address (IP address of the DHCP client) to the device (when a DHCP client boots, it transmits a DHCP discover message and the DHCP server responds with available IP address, see, e.g., col. 4, lines 4-10 and figure 8).

Regarding claim 35, Reichmeyer teaches as follows:

The device (DHCP client, 10 in figure 1) is assigned to a domain in the data network, and the domain name sent in the request message (DHCP request, 18 in figure 1) is the name of this domain (DHCP client broadcast DHCP request message to the DHCP server selected, each request message including a server identification which as the same as a network IP address, see, e.g., col. 4, lines 14-17).

4. Claims 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer et al. (hereinafter Reichmeyer)(U.S. Patent No. 6,286,038 B1) and Choudhry (U.S. Patent No. 6,442,602 B1) in view of Skemer et al. (hereinafter Skemer)(U.S. Patent No. 6,570,849 B1).

Regarding claims 18 and 31, Reichmeyer and Choudhry teach all the limitations

of claims 17 and 30 as explained above except for using voice over Internet protocol on the data network.

Skemer teaches as follows:

The Voice over IP gateway for converting telephony and other voice-band signals and signaling information into IP packets over an access network, which is an established packet based network (see, e.g., col. 7, line 65 to col. 8, line 4 and figure 1).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer and Choudhry to use data network for voice data on the basis of the Internet protocol as taught by Skemer in order to utilize existing data network capacity by interleaving voice IP traffic onto the current data traffic.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 17, 26 and 30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 23 and 27 of copending Application No.

10/884,485.

Because the copending application teaches all the limitations of the applicant's claims as listed above.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Response to Arguments***

7. Applicant's arguments filed 7/26/2007, with respect to claims 16-22, 24-28 and 30-36, have been fully considered but they are not persuasive.

A. Summary of Applicant's Arguments

In the remarks, the applicant argues as followings:

1) Provisional Double Patenting Rejection; and

2) Reichmeyer teaches "the device automatically get the network IP address, associated with the network device so the DHCP server does not need to convert between the domain name an IP addresses." An IP address associated with the device cannot reasonably considered as an address information of a parameter server. Furthermore, the IP address of the device cannot be used to set up a connection parameter server. Moreover, the Examiner points out the Reichmeyer teaches storing the IP address on the device as a result of DHCP request. An IP address learned as a result of a request cannot reasonably be considered a domain name used in the request message.

B. Response to Arguments

In response to argument 1), the applicant's amended claims cannot overcome this provisional double patenting rejection under 35 U.S.C. 101 because both copending application and the applicant's claims are drawn to the same invention summarized as follows:

A method for configuring a device in a data network comprising storing a address of an address assignment server (applicant's domain name is defined as an address of a computer network connection and identifies the owner of the address, see, e.g., The American Heritage Dictionary of the English Language Fourth Edition 2000), transmitting an inquiry message (applicant's request message), transmitting address information, establishing a connection and transmitting parameters.

In response to argument 2), Reichmeyer teaches two steps in figure 8, one is DHCP discover/offer to obtain the network device's IP address (applicant's domain name in applicant's step a) and the other step is DHCP request/acknowledge to obtain central configuration server's IP address (applicant's parameter server address information in applicant's step c)(see, e.g., col. 7, line 59 to col. 8, line 17).

Therefore Reichmeyer teaches as follows:

Network device's IP address was not considered as the address information of the parameter server;

The IP address of the network device is used to set up a connection to the configuration server (applicant's parameter server) because the originating address (network device IP address) and destination address (configuration/parameter server address) are the main information to make connection between them which inherently exist in any packet data unit (PDU)); and

The applicant's claim 17 does not support that the address information learned from applicant's step c is equivalent to the domain name in step a. Examiner interpreted

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the domain name as the network device's address and the address information as the configuration server's IP address.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeong S. Park whose telephone number is 571-270-1597. The examiner can normally be reached on Monday through Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER

JP

September 18, 2007